

REMARKS

In the Office Action dated March 21, 2007, the Examiner has set forth a requirement for restriction under 35 U.S.C. §121, alleging that the subject matter defined by the claims of the present invention represents the following two separate and distinct inventions:

- Group I. Claims 1, 3-27, 39-53, and 55-60, 63 and 64, drawn to a flavor improver and product containing same, classified in class 426, subclass 650.
- Group II. Claims 28-38, drawn to a process for producing an edible flavor improver, classified in class 426, subclass 650.

In order to be fully responsive to the Examiner's requirement for restriction, Applicants provisionally elect to prosecute the subject matter of Claims 1, 3-27, 39-53, and 55-60, 63 and 64, drawn to a flavor improver and product containing same, classified in class 426, subclass 650. Applicants reserve the right to file one or more divisional applications directed to the non-elected subject matter in this application.

However, pursuant to 37 C.F.R. §§ 1.111 and 1.143, Applicants hereby traverse the Examiner's requirement for restriction and request reconsideration thereof in view of the following remarks.

An Examiner's authority to require restriction is defined and limited by statute:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.

35 U.S.C. § 121, first sentence (emphasis added). The implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions which are both independent and distinct, 37 C.F.R. §§1.141-142. Without a showing of independence and distinctness, a restriction requirement is unauthorized. In the present

application, the claims which the Examiner has grouped separately are not "independent and distinct" so as to justify the restriction requirement.

The Examiner acknowledges that Groups I-II are related as a process of making and product made. However, Examiner contends that Groups I-II are patentably distinct inventions because the product (Group I) as claimed can be made by another and materially different process and the process (Group II) as claimed can be used to make another and materially different product.

In the first instance, Applicants respectfully submit that MPEP states that the inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP §806.05(f), emphasis added). In the Restriction Requirement, the Examiner fails to show any example of a product in Group I that can be made by another and materially different process from that of Group II or a process in Group II that can be used to make another and materially different product from that of Group I. The Examiner simply asserts a conclusion.

Moreover, Applicants respectfully submit that the present invention recognizes that it is possible to obtain a useful flavor improver from a product which in the prior art has been considered as foul waste, at best fit for mixing into animal feed in small enough amounts not to spoil the taste of the feed. The product of the invention not only improves the flavor of human food, its flavor improving capacity is so great that it improves the flavor even when added to ingestible products at the surprisingly low level of 1 to 2000 ppm.

Applicants submit that as the Examiner has conceded that Group I and Group II are related since the process of Group II can be used to produce the flavor improver of Group I.

Applicants respectfully submit that Groups I and II are based on the same inventive concept of the present invention and are merely different aspects of a single invention. The process of Group II embodies the concept of Group I and merely teaches how to make and use the flavor improver of Group I. Thus, Applicants respectfully submit that Groups I and II are interdependent and interrelated and are not independent.

Applicants submit that the courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973). This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

The Examiner also states that the inventions have acquired a separate status in the art as evidenced by the alleged divergent subject matter and would require independent searches.

In this regard, Applicants respectfully submit that the Restriction Requirement is not in compliance with the MPEP. It is noted that Groups I and II are classified in the same class (426) and subclasses (650). Applicants respectfully direct the Examiner's attention to MPEP § 808.02, which states "where however, the classification is the same and the field of search is the same and there is no clear indication of separate future and field of search, no reasons exist for dividing among related inventions". Applicants submit that as shown hereinabove, the

classifications of the various groups are identical. Moreover, the field of search of the alleged two groups are the same and the U.S. Patent and Trademark Office has not provided any evidence of separate future classifications for this field of search. Thus, in accordance with the MPEP, there is no reason for dividing among these related groups.

Therefore, Applicants respectfully submit that the subject matter Groups I-II are linked by a single inventive concept – they are merely different aspects of a single invention. Groups I-II are not “independent and distinct”.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant’s financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), applicants are required to conduct simultaneous prosecution, as here, requiring excessive filing costs or to otherwise compromise the term of related patent assets.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application “shall not be used as a reference” against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that § 121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle GmbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir.

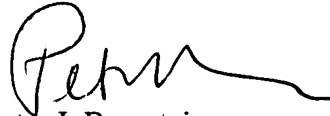
1986). In Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), the court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public interest in the legitimacy of issued patents, Applicants respectfully urge the Examiner not to require restriction in cases such as the present application wherein various aspects in a unitary invention are claimed.

Finally, Applicants respectfully submit that a determination to make the pending restriction requirement final must evidence the patentable distinctness of all defined two groups, one from the other, as presented by the Examiner.

In view of the foregoing comments, it is respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter I. Bernstein', with a long horizontal flourish extending to the right.

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